

REMARKS

Claims 1-5 and 8-11 are pending in the application and stand rejected. Claims 12-15 are newly added and are all directed to originally disclosed subject matter. No new matter has been added.

Rejection under 35 U.S.C §103

Claims 1-4 and 7-11 stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,629,980 to Stefik et al. in view of the Crabb publication. In particular, the Examiner finds that, with regard to claim 1, Stefik discloses all of the claimed limitations with the exception of representing at least one motion corresponding to at least one constituent of the computer graphics character data item. The Examiner further finds that Crabb teaches software allowing users to create and animate 3-D art using software tools for the Mac or PC. The Examiner concludes that it would have been obvious to modify the system and method of Stefik to represent at least one motion, the motion corresponding to at least one constituent of the computer graphics character data item as taught by Crabb, in order to provide content creators the ability to create digital works using motion, text, audios and/or music. Applicants respectfully disagree.

“To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.” MPEP §2142. Furthermore, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some *rational underpinning* to support the legal conclusion of obviousness.” *In re Leonard Kahn*, 04-1616, *p. 15 (Fed. Cir., March 22, 2006) [emphasis added]. The Examiner has set forth not the slightest hint of such motivation, real or otherwise, in either of the cited references nor has he invoked the general knowledge of those skilled in the art. To merely state the benefit conferred by the invention is not setting forth the required showing of motivation but rather merely applying the benefit of hindsight to its fullest in combining disjointed references with the benefit of the invention itself as an explicit roadmap.

“Second, there must be a reasonable expectation of success... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.” MPEP §2142. The Examiner has offered not one single detail as to how exactly the skilled person would go about modifying the system and method of Stefik as alleged. Crabb is a rather cursory review of a piece of children's software. Stefik is an issued U.S. patent directed to controlling the use and distribution of digital works. It is certainly not immediately apparent how the skilled person would go about implementing the general statements of the Crabb review into the detailed and complex Stefik scheme, and the Examiner's conveniently conclusive remarks fall far short of the burden imposed by the Rules and the MPEP.

“Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP §2142. The Examiner has made no showing of where each and every claimed limitation that is missing in Stefik may be found in Crabb. The disclosure in Crabb related to animation consists solely of the following two passages:

The Animate section lets them set their custom cartoons to music. With 300 different Dancing Stamps of their favorite Disney characters, they can really embellish their work. They can choose from 15 different musical styles, including rock, swing, island and classical.

...

After selecting a background and dragging a character from the bottom of the screen onto their page, they click on the "Animate" button to bring their artwork to life.

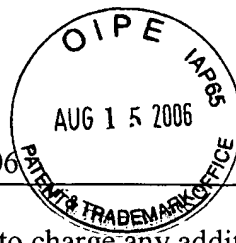
Applicants respectfully submit that to go from the above to Stefik to Applicants' claims is clearly an undertaking that relies on Applicants' claims as an explicit roadmap not just to finding disparate and completely unrelated references but also to discerning therein, however dimly, the claimed limitations – just as the Examiner has done presently.

The preceding notwithstanding, Applicants desire to pass this case to issue and therefore, solely for the purpose of more clearly setting forth the differences between the prior art on record and the claimed invention, have further amended the claims as shown on the preceding pages. As the Examiner will appreciate, Stefik does not disclose the presently claimed limitations such as, *inter alia*, dividing the registered computer graphics character data item into a plurality of constituents, and combining the registered motion data with the divided constituents to thereby impart the motion to the computer graphics character. The Examiner must also keep in mind that the presently claimed devices and methods perform these two actions automatically, with no input from the user. Support for the newly presented amendments may be found at page 13, line 16 to page 14, line 26 of the originally filed specification.

Applicants further note that with respect to amended claims 3 and 11, Stefik fails to teach or allude to presenting the registered at least one computer graphics character data item and the various motions represented by the registered editing data to the at least one client terminal via the network, accepting selection of a computer graphics character data item and at least one motion from the computer graphics character data item and the various motions presented by the first presentation device, and combining the editing data including motion data representing the selected motion with the selected computer graphics character data item to thereby impart the selected motion to the computer graphics character representing a look of a human being or an animal.

Claims 2, 5, 8 and 9 depend from claim 1, and claim 4 depends from claim 3. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, in light of the above discussion of independent claims 1, 3, 10 and 11, Applicants submit that claims 2, 4, 5, 8 and 9 are also allowable at least based on their dependencies. Newly presented claims 12-14 depend from claims 1 or 3, respectively, and Applicants thus submit that they are patentable at least based on their dependencies.

In view of all of the foregoing, Applicants respectfully submit that the claims as amended herein are novel and non-obvious over Stefik in view of Crabb and urge the Examiner to kindly reconsider and pass the claims to issue.



The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

I hereby certify that this correspondence is being deposited with the United States Post Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

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(Date of Transmission)

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